

Appl. No. 09/676,690
Amdt. dated December 11, 2003
Reply to Office Action of September 11, 2003

REMARKS/ARGUMENTS

In this amendment, claim 9 has been amended to correct the informality identified in item 3 of the Office Action. The Applicant submits herewith a certified copy of the priority document under 35 U.S.C. § 119(b) as requested in item 2 of the Office Action. Favorable reconsideration is respectfully requested.

Claim Rejections – 35 USC §103(a)

In paragraphs 5-19 of the Office Action, the Examiner has rejected claims 1-3, 6-9, 12, 16-22, 25-26 and 28 as being unpatentable over Chong et al (U.S. Patent No. 5,497,319, hereinafter “Chong”) in view of Kato (Derwent-Acc-No: 2000-004258, JP 11-282848, hereinafter “Kato”).

With reference to claim 1, the Examiner urged that all the steps of claim 1 are taught by Chong apart from the step of a user clicking a one-click translation component to request translation of a selected communication. However, according to the Examiner, Kato teaches that “text to be translated is selected by clicking the mouse button and dragging it till required,” the translated text appearing on the same location of the screen on release of the clicked button of the mouse. On this basis, the Examiner concluded that the invention as claimed in claim 1 would have been obvious to a person with ordinary skill in the art at the time the invention was made because the teachings of Chong could be modified by the teachings of Kato to reach the invention as claimed.

Applicant respectfully submits that the Examiner has incorrectly interpreted the teachings of both Chong and Kato such that even if the person of ordinary skill attempted to combine the teachings of Chong and Kato, he/she could not arrive at the invention as claimed.

The Examiner asserts that Chong must inherently comprise some means to enable a user to submit the translation command to a remote server. However, there is no basis for the system disclosed in Chong to inherently comprise and display a translation component to the user to enable the user to submit a translation command to request translation of a selected communication.

With reference to column 6, line 60 to column 9, line 37, Chong discloses a computer server 10 having a receiving interface 11 linked to a telecommunications link A. Input data is

received by the receiving interface 11 in various formats, such as electronic text, facsimile input or page image data. With reference to column 7, line 59 to column 8, line 22, the input data comprises two parts -- the input text to be translated and a cover page or header. The cover page or header, as shown in FIG. 2 of Chong, comprises the details required for the translation to be performed and this must be completed by the user according to the user's requirements. A recognition module 12 interprets the cover page or header and in conjunction with a dictionary control module 13 coordinates translation of the input text by a machine translation module 20. Chong's cover page or header is inconsistent with a one-click translation component for requesting translation of a selected communication.

Clearly, Chong does not disclose, suggest, or render obvious a one-click translation component for requesting translation of a selected communication. The header or cover page cannot be considered to be a translation component, the header or cover page does not request a translation of the selected communication by transmitting the selected communication or an indicator thereof to a translation manager. Therefore a one-click translation component is inconsistent with disclosure of Chong.

In contrast, and as defined in the specification of the present application, for example, on page 4, lines 10-13 and on page 5, lines 6-13, the one-click translation component of the present invention requires only a single action by the user to request a translation of a particular communication. With reference to page 8, line 5 to page 9, line 7, of the specification of the present application, the translation component of the present invention may be, for example, an explorer bar, a pull-down menu, a context menu, a hypertext link or a button displayed in the screen, which is selected by a single click to effect translation of a selected communication. Chong makes no disclosure of such a translation component comprising such functionality.

Modification of Chong by Kato could not result in the invention as claimed. Reference is made to the attached annex enclosing an extract from the www.delphion.com website, which clarifies the teachings of Kato.

Kato is directed to a CD-ROM learning aid to facilitate the correct pronunciation and understanding of English Internet homepages. In Kato, the user is required to perform the action of highlighting the text to be understood. The first press of the mouse button commences the highlighting procedure and the release of the mouse button ends the highlighting procedure

causing a translation of the highlighted text stored on the CD-ROM to be displayed on the same location of the screen as the highlighted text. Simultaneously, the correct pronunciation of the translation is provided "by a user's favorite person."

The teaching of Kato implies to the Applicant that the CD-ROM represents a database of stored translations and pronunciations of Internet homepages that are retrieved from the database according to the position of the mouse pointer and the text highlighted. Kato's learning aid provides "a practical and enjoyable learning effect of English." Arguably, no translation is being performed as a result of the highlighting process, but merely the retrieval of the relevant text (and pronunciation) that has already been translated and stored on the CD-ROM. Even if a translation process is occurring, Kato neither discloses, suggests, nor renders obvious a one-click translation component to request translation of a selected translation.

Clearly, there are other processes being performed by Kato, which are not expressly disclosed. For example, once the text is highlighted, how is the appropriate translated text retrieved and then displayed in the appropriate location on the screen? The analogy is drawn between Kato and a conventional word processing package. In a conventional word processing package, text may be highlighted, cut and then pasted in a different location and a program running in the background enables this to be done. Kato probably functions in a similar manner to a word processing package in that highlighted text is replaced with previously translated text and provided with a correct pronunciation from the CD-ROM. Hence, even if a translation is being performed by Kato, which seems unlikely, Kato clearly does not teach a one-click translation component.

It should be noted that the invention of the present application also allows the user to optionally highlight the text to be translated (see page 8, lines 9-13), for example, if only part of a page needs to be translated. However, translation is still effected by the one-click translation component, which, in this example, is in the form of a context menu displaying a "translate selection" option. Hence, the one-click translation component of the present invention, the activation of which effects translation, is to be distinguished from the act of a user highlighting text by clicking, dragging, and unclicking to display a translation and simultaneously receive a correct pronunciation as taught by Kato.

Therefore, the combination of Chong and Kato does not result in the translation ordering method of independent claim 1, the single-click translation ordering system of independent claim 17, or the translation manager for a one-click translation system of independent claim 26, since the modification of Chong by Kato would not result in a one-click actuation of a translation component to request translation of a selected communication. Therefore, independent claims 1, 17, and 26 and the claims dependent thereon are not made obvious by Chong in view of Kato.

That Chong is directed to a machine translation and communication system and Kato is contrastingly directed to a teaching aid in the form of a CD-ROM indicates a lack of motivation to combine the two references. A teaching or motivation to combine Chong and Kato must be "clear and particular" (*In re Dembiczaik*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)). Such a teaching or motivation is absent in the present situation.

The Applicant respectfully submits that in formulating the obviousness objections, the Examiner has relied on hindsight, working backwards from the invention as claimed rather than from the inventor's stand point of the problem to be solved working forward towards the invention as claimed.

In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971), it was stated that:

[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.

That the Examiner has relied on hindsight is reinforced by the complete absence from Chong and Kato of a translation component, one-click or otherwise, to request translation of a communication. The one-click translation component having the functionality as described in the specification of the present application has been gleaned only from the Applicant's disclosure, thus rendering the Examiner's reconstruction improper.

In view of the foregoing, Applicant respectfully submits that claim 1 would not have been obvious from the combined teachings of Chong and Kato. Withdrawal of the rejection is requested.

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The remaining claims were rejected under Section 103(a) based on the modification of Chong by Kato and one or more other documents. Applicant respectfully submits that these rejections are redundant based upon the foregoing arguments relating to claim 1.

Applicant respectfully asserts that claims 1-28 are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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